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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,267	08/04/2003	Michael Kendall	078743-2002	7077
30542	7590	03/11/2005	EXAMINER	
FOLEY & LARDNER P.O. BOX 80278 SAN DIEGO, CA 92138-0278			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

GN

<b>Office Action Summary</b>	<b>Application No.</b> 10/634,267	<b>Applicant(s)</b> KENDALL, MICHAEL	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 9-11, 13-15, 18 and 55-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 12, 16, 17, 19-54 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/7/03</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Election/Restrictions***

1. Applicant's election without traverse of species I in the reply filed on 10/29/04 is acknowledged.
2. Applicant's election with traverse of subspecies A, figure 2 in the reply filed on 10/29/04 is acknowledged. The traversal is on the ground(s) that figure 2 is generic to a variety of means. This is not found persuasive because it appears to show in figure 2 a permanent means, such as integrally molding, that does not include additional structural means for attaching the lattice to the scaffolding, such as grommets and other fastening means as that shown in figures 5 and 6 or not shown at all.

The requirement is still deemed proper and is therefore made FINAL.

1. Claims 5-7, 9-11, 13-15, 18, and 55-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and/or subspecies, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

***Claim Rejections - 35 USC § 112***

2. Claims 1-4, 8, 12, 16, 17, 19-54, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 58 the phrases "one or more...or metal alloy material" and "the sole of the foot, or a weight bearing portion" are alternative, vague, and indefinite.

In claims 1 and 58 the phrase "high to medium modulus polymer", in claims 19 and 23 the phrase "medium modulus fibers", in claims 25 and 27 the phrase "high modulus

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fibers", in claims 26, 29, and 31 the phrase "low modulus fibers" are vague and indefinite because it is not clear what applicant considers to be low, medium, or high modulus fibers. These are relative terms and it is not clear what limitations applicant intends to encompass with such terms. Also, claims 26, 29, and 31 appear to contradict claim 1 from which they depend.

In claim 27 the phrase "the polymer fibers" lack antecedent basis rendering the claim vague and indefinite.

In claims 21 and 22 the term "Hytrel" is a trademark rendering the claim vague and indefinite.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 12, 16, 17, 19, 23-28, 32, 40-42, 47-54, and 58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Graham (5070629).

In reference to claims 1, 19, 23, 25-27, 29-31 and 58, the fibers disclosed by Graham are considered to be high, medium, and/or low modulus dependent on what they are being compared to. In reference to claims 2 and 8, element 18 is considered to be a cushioning pillar inasmuch as applicant has defined and claimed such. In reference to claim 32, see figures 16 and 17. In reference to claims 40-42, see figures 3, 13, 14, 16, 18, and/or note column 9 lines 1-23.

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5. Claims 1, 2, and 46-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipfert (4283864).

Lipfert shows a sole construction comprising a lattice (64), scaffolding (30) with pillars (72 and 74) inasmuch as the claims are understood.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-31 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham (5070629).

Graham shows a shoe sole substantially as claimed except for the exact materials for the fibers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use high, low, medium, specific materials as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice to obtain a desired result. *In re Leshin*, 125 USPQ 416.

8. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham '629 in view of either Lodispoto (4681114) or Jackinsky (5592757).

Graham '629 shows a shoe sole substantially as claimed except for being designed to carry the forefoot higher than the heel. Either Lodispoto or Jackinsky teaches

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forming shoe soles so that they carry the forefoot higher than the heel. It would have been obvious to form the shoe sole to carry the forefoot higher than the heel as taught by either Lodispoto or Jackinsky in the shoe of Graham '629 to improve the wearers walk or to treat hyperlordosis.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-4, 8, 12, 16, 17, 19-54, and 58 are rejected under the judicially created doctrine of double patenting over claims 1-51 of U. S. Patent No. 6601321 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim a sole with scaffolding means and a lattice and the patented claims incorporate additional limitations which are not present in

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the currently pending claims and therefore it would have been obvious to remove these limitations.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

***Allowable Subject Matter***

11. Claims 33-38 and 43 are would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728